

## REMARKS

### Introductory Comments

As of the mailing date of the 10/03/2008 Office Action, claims 17-21 and 23 were pending in the present application. In the present Response, no claims have been canceled, amended, or added, so claims 17-21 and 23 remain for consideration upon entry of the present Response. Reconsideration and allowance of the claims is respectfully requested in view of the following remarks.

### Claim Rejections Under 35 U.S.C. § 103(a)

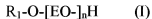
Claims 17-21 and 23 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Mather et al. (WO 96/39119) in view of Martino et al. (US 5,011,630). 10/03/2008 Office Action, page 2, fourth paragraph. Applicants respectfully traverse this rejection.

Applicants respectfully assert that claims 17-21 and 23 are patentable over Mather in view of Martino because a person of ordinary skill in the art would not modify Mather by utilizing a particular species of Martino's component (b) water soluble monohydroxy-terminated blocked polyalkylene oxide in place of Mather's glycol base.

The Supreme Court has recently reaffirmed the principle that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the art". *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). The Court further stated that "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does". *Id.* And the Court expressly encouraged the use of common sense in such analysis. *Id.* Furthermore, while the KSR decision may have eliminated any rigid requirement for application of the teaching-suggestion-motivation test (TSM test), it did not disturb the longstanding principle that "a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore &*

*Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).” MPEP 2141.02 (emphasis in original).

Applicants’ claim 17 – the only independent claims – is directed to an ether alcohol/polyol-in-oil emulsion comprising at least one ether alcohol of the general formula (I)



where  $R^1$  is  $C_{1-3}$ -alkyl,  $n$  is on average 7 to 15, and EO is building blocks derived from ethylene oxide, in an oil-immiscible ether alcohol/polyol phase, an oil phase and at least one emulsifier. The Office Action concedes that the primary reference, Mather, does not teach the ether alcohol of general formula (I). 10/03/2008 Office Action, page 4, first full paragraph. The Office Action then states, “It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of the two cited references and use [Martino’s] specific ether alcohol of general formula wherein the number of ethylene oxide units is 7 in the compositions as taught by Mather et al.” 10/03/2008 Office Action, page 6, first paragraph. Applicants respectfully disagree. Specifically, because of the different structures and functions of the ether alcohols in Mather and Martino, and because of the different uses of the final compositions of the references, a person of ordinary skill in the art would not modify Mather’s solutions by substituting an ether alcohol from Martino’s emulsions.

Mather refers to topical compositions “containing azelaic acid stabilized and completely solubilized in a glycol base”. Mather, page 5, lines 30-31 (emphasis added). The glycol in Mather has the function that it “easily and completely dissolves the azelaic acid without affecting the stability of the azelaic acid”. Mather, sentence bridging pages 5 and 6 (emphasis added). Thus, Mather’s procedures and compositions yield a solution of azelaic acid. See, e.g., Mather working examples at page 7, lines 7 and 31, and page 8, line 22 (all mentioning “a clear solution” of azelaic acid in glycol base). Mather’s solution can then be used for preparing conventional emulsions with cosmetic oils. Mather, page 6, lines 19-24.

Martino relates to water dispersible, self-emulsifiable triglyceride compositions comprising the reaction product of (a) a specific addition product of a triglyceride oil of a fatty acid with an olefinic carboxylic acid, and (b) a monohydroxy- (or monoamino-) terminated blocked polyalkylene oxide. Martino, column 2, lines 9-26. An example of Martino's component (b) is polyethylene glycol monomethyl ether (PEGMME), which is used in some Examples. See, e.g., Martino, column 6, lines 10-11, 35, 65; column 7, Table III. Note that Martino's component (b) is reacted with the addition product (a) by esterification or amidification (column 3, lines 53-60) to provide the reaction product, which is water dispersible and self-emulsifiable (column 2, lines 24-25). The reaction products so obtained may be used "as emulsifying agents for various compounds useful in aqueous emulsion form such as, for example, cellulose reactive sizing agents" in paper manufacturing. Martino, column 4, lines 58-61. Thus, Martino's component (b) monohydroxy-terminated blocked polyalkylene oxide is used for a completely different purpose than the glycol base in Mather. Simply put, the components in Mather and Martino that the Office regards as analogous have different structures and different chemical functions and are used to form very different final products. Mather uses the glycol as a solvent for dissolving and stabilizing azelaic acid. Martino uses the ether alcohol as a reactant to form an esterification reaction product. The final composition of Mather is in the form of a solution. In Martino, the reaction product is water dispersible and self-emulsifiable. Furthermore, the proposed uses of the final compositions of Mather and Martino are distinct. Mather uses the azelaic acid-glycol solution for preparing pharmaceutical and cosmetic compositions (see, e.g., Mather, page 1, lines 14-21; page 6, lines 23-24), whereas Martino's reaction product is used to form emulsions of cellulose-reactive sizing agents for use in paper manufacturing (see, e.g., Martino, column 9, Example 10).

Given the different chemical structures and functions of Mather's glycol base and Martino's component (b), and given the different end uses of the compositions formed from them, it defies common sense and ignores the teaching of each reference as a whole to suggest that a person of ordinary skill in the art would modify Mather by substituting a particular species of Martino's component (b) monohydroxy-terminated blocked polyalkylene oxide for Mather's glycol base. Accordingly, a prima facie case of

obviousness based on Mather and Martino has not been established. Applicants therefore respectfully request the reconsideration and withdrawal of the rejection of claims 17-21 and 23 under 35 U.S.C. § 103(a) over Mather in view of Martino.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is respectfully requested.

It is believed that all the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Assignee.

Respectfully submitted,

CANTOR COLBURN LLP  
Applicants' Attorneys

By: /J. Michael Buchanan/  
J. Michael Buchanan  
Registration No. 44,571

Date: December 23, 2008  
Customer No.: 23413  
Telephone: (860) 286-2929